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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,440	09/15/2003	R. Brooke Dunn	115582-021	1598

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EXAMINER	
HARPER, TRAMAR YONG	
ART UNIT	PAPER NUMBER
3714	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/28/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/663,440	DUNN ET AL.	
	Examiner	Art Unit	
	Tramar Harper	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 January 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *1/26/07*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Examiner acknowledges receipt of amendment on 1/23/07. The arguments set forth in the response are addressed herein below. Claims 1-28 are pending and Claims 1-3, 5-6, 13, and 24-26 have been amended.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 7-12 are apparatus claims dependent on method Claims 1-6. Apparatus claims and method claims should be claimed separately. Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 26 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 11 & 18 of copending Application No. 10/086014. Although the conflicting claims are not identical, they are not patentably distinct from each other because Claims 1 and 26 are encompassed with the scope of broader copending Claims 11 & 18, which are drawn to triggering a game, associating a plurality of values with a plurality of selections, displaying said plurality of selections, revealing at least one of the values associated with one of the available selections, shuffling or rearranging the selectable selections, enabling a player to pick or select a selection, and providing the player the value of the said selection.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-17 and 19-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gauselmann (US 2003/0216167) in view of Hughs-Baird et al (US 2003/0162584).

Claims 1, 7, 13, 24, 26, & 28: Gauselmann teaches a gaming device with a main and a bonus game that comprises of:

a processor/cpu for running game programs that control the main and bonus games and for controlling the game display (¶ 25);

a wager for initiating the game (¶ 20)

a plurality of main game outcomes which includes a triggering bonus game outcome;

triggering the bonus round;

displaying/previewing the plurality of selectable awards in an order unrelated to how the awards are hidden or masked;

the player makes M amount of choices in attempt to win or accumulate the hidden awards that revealed upon selection; and

the bonus round ends upon the selection of an end game option (Abstract, ¶ 7).

Gauselmann is silent in regards to previewing the plurality of selectable awards, masking the awards, and rearranging the awards such that the awards differently from which they are position. Hughs-Baird et al. discloses a bonus game that comprises of briefly revealing one or more awards associated with possible selections, concealing the awards, and reshuffling the awards in a different configuration different from what is previewed. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the bonus game of Gauselmann such that the actual

awards were revealed, masked, and the rearranged, as taught by Hughs-Baird to provide a bonus game having direct player interaction, wherein the player can see and further anticipate the possibility of further wins. As such, increasing the popularity of the game (Gauselmann ¶ 3-4).

Claims 2-6, 8-12, 14-16, 25, & 27: Gauselmann discloses that the assemblage of selectable hidden outcomes/awards may include credits, monetary values, multipliers, free bonus game (free spin), or an end of game option (¶ 7). In one embodiment, a player is only allowed to make M amount of choices, M being less than the total available selections and then bonus game ends (¶ 40). In another embodiment, a player is allowed five chances to match three symbols, the player is awarded bonus based on the match, and the bonus game ends (¶ 38), which is also interpreted as the player replacing at least one player selection. The end bonus option ends the bonus game and brings player back to main game (¶ 36).

Claim 17: Player touches the screen or door on screen to reveal hidden value behind door (¶ 29).

Claim 19: Player keeps making selections until the end-bonus option is selected and the game ends (¶ 36).

Claims 20-21: Gauselmann discloses that the main game comprises of a rotating reel type game and upon a special combination of symbols obtained in the game the bonus game is triggered (¶ 26). The said special combination of symbols represents the start bonus symbols.

Claim 22: Gauselmann discloses that the player is allowed to make M amount of choices, M being less than the total available selections and then bonus game ends (¶ 40). Thus, the last choice is the choice that ends the game, but also can be a credit value.

Claim 23: Please refer to Fig. 9, in which the gaming device grants awards based on the sum of selected values (¶ 40).

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gauselmann (2003/0216167) in view of Hughs-Baird et al (US 2003/0162584) in further view of Kaminkow (US 6,511,375).

Claim 18: The combination of Gauselmann and Hughs-Baird discloses all the limitations of Claim 13, as stated above, but excludes the teaching of revealing all selectable elements, whether unselected or selected by the player, at the end of a bonus game. The Applicant admitted prior art of Kaminkow discloses a bonus game of selectable elements, where all selectable elements unselected or selected are revealed when the bonus round ends (Col. 10:66-Col. 11:5). It would have been obvious to one of ordinary skill at the time of the invention to modify the bonus game of Gauselmann & Hughs-Baird such that upon the selection of an end bonus outcome all selectable elements are revealed, as taught by Kaminkow. The above modification would provide the player with the knowledge of missed opportunity and add to the excitement of the game. Thus, increasing a player's interest in the game and possibly promoting further game play.

Response to Arguments

Applicant's arguments with respect to Claims 1-26 have been considered but are moot in view of the new ground(s) of rejection. The previous independent claims did not clarify that the actual previewed awards are masked and rearranged. Gauselmann disclosed displaying the possible awards and displaying beside the possible awards, masked possible awards that are arranged differently to the previewed awards. Which is interpreted as awards rearranged differently from the viewed awards. However, the clarified amended claims overcome that interpretation.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kaminkow (US 6,659,864) teaches player selectable elements where player can swap awards.

Thomas (US 6,190,255) teaches player selectable elements that comprise of end-bonus selection with an associated credit value.

Baerlocher (US 6,575,830) discloses a bonus game that ends upon player swapping awards to obtain the ultimate award.

Luccesi (US 2003/0045343), Gauselmann (US 2005/0054414), and Bennett (US 6,572,471) all teach similar gaming devices with bonus selectable elements.

Gerrard (US 2004/0048644) and Berman (US 2005/0119040) teach bonus games comprising of a shell type game with selectable elements.

Walker (US 6,174,235) teaches a bonus game with player selectable elements that are all revealed prior to selection.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tramar Harper whose telephone number is (571) 272-6177. The examiner can normally be reached on 7:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TH

3/22/07

ROBERT E. PEZZUTO
SUPERVISORY PRIMARY EXAMINER